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UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
HILLERY, NATHAN

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2176	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/749,918	VAN DER MEER, HENDRIK THEODORUS
	Examiner	Art Unit	
	Nathan Hillery	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>06 October 2005</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,3-19 and 21-35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,3-19 and 21-35* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE filed on 10/6/05.

2.   Claims 1, 3 – 19, 21 – 35 are pending in the case. Claims 1, 4, 5, 19, 22 and 23

are independent.

3.   The rejection of claims 1 – 35 under 35 U.S.C. 103(a) as being unpatentable has

been withdrawn as necessitated by amendment.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1, 3 – 8, 13 – 17, 19, 21 – 24 and 30 – 34 are rejected under 35

U.S.C. 102(b) as being anticipated by Maxwell (US 5805810 A).

6.   **Regarding independent claim 1**, Maxwell teaches that *As explained, the*

message validator 22 constructs mail objects from email messages, which mail objects

use information from the sender database 1300 and the recipient database 1400, and

queues the mail objects in a print queue (step 750). The print queue processor 24

processes the mail objects in the print queue. The print queue processor 24 is also a

software component, including procedure 1200 (illustrated in FIG. 12) executable by the

print server 18 in the preferred implementation. By software component it is meant that

the print queue processor 24 comprises a set of computer program instructions that

dictate a set of functions and operations to be performed by the print server 14... the

print queue processor 24 selects a mail object from the print queue (step 1220), and

prints the mail object as a postal mail (or netgram) on printer 20 (step 1230). Netgrams

include a letter and corresponding envelope. Printed on each letter is the text from an

email message received by the system 10. The printer 20 prints on an envelope the

return address (i.e., a street address for the sender) and the address (i.e., street

address) of the intended recipient of the netgram, including necessary information for

the U.S. postal service to deliver the netgram. Mail objects selected from the print

queue and printed by the printer 20 are taken out of the print queue (Column 12, lines

38 – 67), which is synonymous with **selecting a single priorly stored file of**

presentation instructions (*sender's database*) **including instructions concerning a**

design of printed content to be printed on the documents (*information from*

sender's database)**, and instructions concerning making said printed documents**

ready for mailing (*information from sender's database*)**; transferring a file of content-**

determining printing instructions (*mail object*) **and said presentation instructions**

to a peripheral system for printing and for at least making ready for mailing said

printed documents; and printing said documents in accordance with said file of

content-determining instructions and said instructions concerning the design of

the documents to be printed; and making said printed documents ready for

mailing in accordance with said instructions concerning making ready said

printed documents for mailing.

7.   **Regarding dependent claim 3**, Maxwell teaches that *The Netgram system 10*

permits users to send email messages as postal mail addressed to an intended

recipient who may not have access to the Internet by identifying the recipient using an

identifier or nickname. Once users send email messages addressed to intended

recipients using the selected nicknames, the Netgram system 10 maintains databases

including the nicknames and corresponding postal address information for each

recipient based on the identity of the sender. Thus, the Netgram system 10 may

receive multiple email messages addressed to, for example, "mom@netgram.com" from

different senders and determine who is to receive each postal mail by referring to the

databases. (Column 4, lines 30 – 42), which is synonymous with **selecting said file of**

presentation instructions is carried out by selecting a symbol which represents

said file of presentation instructions.

8.   **Regarding independent claim 4**, Maxwell teaches that *The Netgram system 10*

permits users to send email messages as postal mail addressed to an intended

recipient who may not have access to the Internet by identifying the recipient using an

identifier or nickname. Once users send email messages addressed to intended

recipients using the selected nicknames, the Netgram system 10 maintains databases

including the nicknames and corresponding postal address information for each

recipient based on the identity of the sender. Thus, the Netgram system 10 may

receive multiple email messages addressed to, for example, "mom@netgram.com" from

different senders and determine who is to receive each postal mail by referring to the databases. (Column 4, lines 30 – 42), which is synonymous with **selecting said file of presentation instructions is carried out by selecting a symbol which represents said file of presentation instructions; activating a send dialog program, subsequently displaying at least one symbol which represents a file of presentation instructions; wherein selecting said file of presentation instructions occurs by selecting a symbol which represents said file of presentation instructions, subsequently entering a send command and subsequently at least making ready for mailing said documents in accordance with said selected file of presentation instructions.** Further, the limitations not addressed in independent claim 4 incorporate substantially similar subject matter as claim 1 and are rejected along the same rationale.

9.   **Regarding dependent claim 6**, Maxwell teaches that *After printing a netgram, the print queue processor 24 determines whether the print queue is empty (step 1240). If the print queue is empty (step 1240), then processing by the print queue processor 24 ends (step 1245). Otherwise, when the print queue is not empty (step 1240), the print queue processor 24 returns to perform the functions of steps 1220-1240, selecting another mail object from the print queue (step 1220), printing a netgram from the selected mail object (step 1230), and determining again whether the print queue is empty (step 1240)* (Column 13, lines 1 – 10), which is synonymous with **in response to a selection of a different file of presentation instructions, the same peripheral**

system is driven for at least making ready for mailing another plurality of

documents.

10.   **Regarding independent claim 5**, Maxwell teaches that *In reviewing the*

information in a sender's account record (step 640 in FIG. 7) or after determining that a

sender account record is not located in the sender database 1300 (step 620), the

message validator 22 determines whether the sender's account contains sufficient credit

for postage (step 640) to complete the process of generating a mail object, printing the

postal mail, and providing the postal mail to, for example, the U.S. Postal Service for

delivery to an identified recipient (addressee). As explained below with reference to

FIG. 13, the sender account records in the sender database 1300 specify whether a

sender has paid for or established an account to pay for required postage (Column 9,

lines 19 – 30), which is synonymous with **selecting said presentation instructions**

occurs under a particular user authorization and by selecting a priorly stored file

of presentation instructions; and wherein editing said file of presentation

instructions occurs, and is executable, exclusively under a different authorization

than said user authorization. Further, the limitations not addressed in independent

claim 5 incorporate substantially similar subject matter as claim 1 and are rejected along

the same rationale.

11.   **Regarding dependent claim 7**, Maxwell teaches that *The netgram workstation*

16 is a computer workstation, such as a Sparcstation by Sun Computer Corporation,

comprised of a display device, one or more input devices (e.g., keyboard, mouse, etc.),

and a base unit. The base unit includes a central processing unit (CPU) and a storage

device. The netgram workstation 16 is also used to execute software applications,

namely, a message validator and transaction queue processor (described below),

stored on the storage device. The storage device also stores data used by the

executing software applications including a sender database and a recipient database

(described below). (Column 5, lines 7 – 17), which is synonymous with **generating at**

least one file of presentation instructions in accordance with data selected or

entered under said different authorization than said user authorization; and

storing said file of presentation instructions in said computer-readable memory.

12.   **Regarding dependent claim 8**, Maxwell illustrates in Figure 1 **entering data for**

said file of presentation instructions occurs utilizing universal, interactive client-

server operating interface software.

13.   **Regarding dependent claim 13**, Maxwell teaches that *FIG. 1 is a block diagram*

of an email message-to-postal mail generating system (Netgram system) 10. The

Netgram system 10 is designed to receive email messages (from the Internet) and

generate postal mail (also referred to as "netgrams") from the email messages. The

email messages may be sent by any computer user with access to the Internet by

simply sending email messages to the Netgram system 10 using a specific domain

name (e.g., "netgram.com") (Column 4, lines 16 – 23), which is synonymous with **in**

response to the selection of said file of presentation instructions through any one

of at least two different client systems, the said presentation instructions are

used.

14.   **Regarding dependent claim 14**, Maxwell teaches that *The Netgram system 10*

permits users to send email messages as postal mail addressed to an intended

recipient who may not have access to the Internet by identifying the recipient using an

identifier or nickname. Once users send email messages addressed to intended

recipients using the selected nicknames, the Netgram system 10 maintains databases

including the nicknames and corresponding postal address information for each

recipient based on the identity of the sender. Thus, the Netgram system 10 may

receive multiple email messages addressed to, for example, "mom@netgram.com" from

different senders and determine who is to receive each postal mail by referring to the

databases (Column 4, lines 30 – 42), which is synonymous with **in response to the**

selection of said file of presentation instructions under any one of at least two

different user authorizations, the same presentation instructions are used.

15.   **Regarding dependent claim 15**, Maxwell teaches that *The netgram workstation*

16 is a computer workstation, such as a Sparcstation by Sun Computer Corporation,

comprised of a display device, one or more input devices (e.g., keyboard, mouse, etc.),

and a base unit. The base unit includes a central processing unit (CPU) and a storage

device. The netgram workstation 16 is also used to execute software applications,

namely, a message validator and transaction queue processor (described below),

stored on the storage device. The storage device also stores data used by the

executing software applications including a sender database and a recipient database

(described below). (Column 5, lines 7 – 17), which is synonymous with **said file of**

presentation instructions is stored centrally for coupling presentation

instructions according to said file of presentation instructions to content-determining files in response to drive signals coming from a any one of at least two different client systems.

16.   **Regarding dependent claim 16**, Maxwell teaches that *Mail objects selected from the print queue and printed by the printer 20 are taken out of the print queue. After printing a netgram, the print queue processor 24 determines whether the print queue is empty (step 1240).* (Column 12, line 65 – Column 13, line 2), which is synonymous with **in response to addition or deletion of a file of presentation instructions, a list of files of presentation instructions in a memory accessible under said user authorization is updated.**

17.   **Regarding dependent claim 17**, Maxwell teaches that *The Netgram system 10 permits users to send email messages as postal mail addressed to an intended recipient who may not have access to the Internet by identifying the recipient using an identifier or nickname. Once users send email messages addressed to intended recipients using the selected nicknames, the Netgram system 10 maintains databases including the nicknames and corresponding postal address information for each recipient based on the identity of the sender. Thus, the Netgram system 10 may receive multiple email messages addressed to, for example, "mom@netgram.com" from different senders and determine who is to receive each postal mail by referring to the databases.* (Column 4, lines 30 – 42), which is synonymous with **said list of files of presentation instructions is read and displayed in response to activating a send dialog program.**

18.   **Regarding claims 19, 21 – 24**, the claims incorporate substantially similar

subject matter as claims 1, 3 – 6, and are rejected along the same rationale.

19.   **Regarding claims 30 – 34**, the claims incorporate substantially similar subject

matter as claims 13 – 17, and are rejected along the same rationale.

Claim Rejections - 35 USC § 103

20.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

21.   Claims 12, 18 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Maxwell (US 5805810 A) as applied to claims 1 and 19 above.

22.   **Regarding dependent claim 12**, Maxwell does not explicitly teach **a test**

message. However, Maxwell teaches that *The Netgram system 10 permits users to*

send email messages as postal mail addressed to an intended recipient who may not

have access to the Internet by identifying the recipient using an identifier or nickname.

Once users send email messages addressed to intended recipients using the selected

nicknames, the Netgram system 10 maintains databases including the nicknames and

corresponding postal address information for each recipient based on the identity of the

sender. Thus, the Netgram system 10 may receive multiple email messages addressed

to, for example, "mom@netgram.com" from different senders and determine who is to

receive each postal mail by referring to the databases. (Column 4, lines 30 – 42). It

would have been obvious to one of ordinary skill in the art to be motivated, based on the

disclosure and knowledge of the art, to provide for **composing a test message in accordance with presentation instructions of said selected file and sending said test message to a location of a client system with which said file of presentation instructions has been selected**, since the skilled artisan would want the user to be able to send a "test" message to himself in order to see how the system works and how the recipient would receive the message the user wants to send.

23.   **Regarding dependent claim 18**, Maxwell does not explicitly teach **mirror file**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the disclosed invention and provide that **at least one mirror file of presentation instructions coupled to said file of presentation instructions for modifying said mirror file of presentation instructions in response to modifications made in said file of presentation instructions**, since Maxwell teaches that *The netgram workstation 16 is a computer workstation, such as a Sparcstation by Sun Computer Corporation, comprised of a display device, one or more input devices (e.g., keyboard, mouse, etc.), and a base unit. The base unit includes a central processing unit (CPU) and a storage device. The netgram workstation 16 is also used to execute software applications, namely, a message validator and transaction queue processor (described below), stored on the storage device. The storage device also stores data used by the executing software applications including a sender database and a recipient database (described below).* (Column 5, lines 7 – 17); it would be convenient for the user if the skilled artisan kept a mirror file of the current

addressing information locally and then stored any changes to the file in the database

by overwriting the original file.

24.   **Regarding dependent claim 35**, the claim incorporates substantially similar

subject matter as claim 18, and is rejected along the same rationale.

25.   Claims 9 – 11 and 27 – 29 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Maxwell (US 5805810 A) as applied to claims 1 and 19 above and

further in view of McCauley et al. (US006434578B1).

26.   **Regarding dependent claims 9 and 10**, Maxwell does not explicitly teach

displaying a document composed in accordance with presentation instructions of

said selected file. McCauley et al. teach that *the instruction stream will often utilize*

commands and offered features of the requesting client viewer, even though the

commands and features are not offered by different client viewers ... The instruction

stream might utilize many different capabilities unique to particular types of clients, such

as sound, video, animation, recording capabilities, and realtime transmission of these

different types of media (Column 5, lines 31 – 49), which is synonymous with

displaying a document composed in accordance with presentation instructions of

said selected file and that **displaying said document composed in accordance**

with presentation instructions of said selected file occurs by means of universal,

interactive client-server operating interface software (Fig. 1). It would have been

obvious to one of ordinary skill in the art at the time of the invention to combine the

invention of Maxwell with that of McCauley et al. because such a combination would

allow the users of Maxwell the benefit of authoring multimedia content in a generic

format (Column 2, lines 39 – 40).

27.   **Regarding dependent claim 11**, Maxwell does not explicitly teach **animation**.

McCauley et al. teach that *the instruction stream will often utilize commands and offered*

features of the requesting client viewer, even though the commands and features are

not offered by different client viewers ... The instruction stream might utilize many

different capabilities unique to particular types of clients, such as sound, video,

animation, recording capabilities, and realtime transmission of these different types of

media (Column 5, lines 31 – 49), which is synonymous with **displaying, in the form of**

an animation, successive operations for composing a document composed in

accordance with presentation instructions of said selected file. It would have been

obvious to one of ordinary skill in the art at the time of the invention to combine the

invention of Maxwell with that of McCauley et al. because such a combination would

allow the users of Maxwell the benefit of authoring multimedia content in a generic

format (Column 2, lines 39 – 40).

28.   **Regarding claims 27 – 29**, the claims incorporate substantially similar subject

matter as claims 9 – 11, and are rejected along the same rationale.

29.   Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Maxwell (US 5805810 A) as applied to claim 19 above and further in view of

Daniels, Jr et al. (US 6343327 B1).

30.   **Regarding dependent claim 25**, Maxwell does not explicitly teach **instructions for displaying settings concerning presentation instructions; instructions for registering settings concerning presentation instructions as part of a file of presentation instructions in accordance with selected or entered data; and instructions for storing in said computer-readable memory said registered settings concerning presentation instructions as a file of presentation instructions**. Daniels, Jr. et al. teach that *job setups may be defined by a job setup process 520). The job setup process is an interactive application that allows a user to select templates and inserts for each delivery mechanism from a library. For example, electronic mail library 500 includes templates for formatting electronic mail messages* (Column 6, lines 28 – 33), which provide that **instructions for displaying settings concerning presentation instructions; instructions for registering settings concerning presentation instructions as part of a file of presentation instructions in accordance with selected or entered data; and instructions for storing in said computer-readable memory said registered settings concerning presentation instructions as a file of presentation instructions**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Maxwell with that of Daniels, Jr. et al. because such a combination would provide the users of Maxwell with *A message router that delivers the electronic mail pieces via an electronic delivery mechanism specified in the delivery preferences, e.g. to a web server, a pager, a facsimile machine* (Column 2, lines 14 – 17).

31.   **Regarding dependent claim 26**, the claim incorporates substantially similar

subject matter as claim 8, and is rejected along the same rationale.

Response to Arguments

32.   Applicant's arguments with respect to claims 1, 3 – 19, 21 – 35 have been

considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nathan Hillery whose telephone number is (571) 272-

4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

WILLIAM BASHORE
PRIMARY EXAMINER

NH